

AF-1 2779-2  
Attorney File: 2779-2 1/8/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Lawrence W. Krebs et al  
Serial No. 09/110,661  
Filed: July 7, 1998  
For: ATM NETWORK MANAGEMENT SYSTEM

2162  
2661  
Group Art Unit 2762

Examiner B. Phunkulh

APPEAL BRIEF TRANSMITTAL

Hon. Commissioner of Patents and Trademarks  
Washington, D. C. 20231

RECEIVED

DEC 26 2001

Technology Center 2100

Sir:

Attached hereto are three (3) copies of the BRIEF ON APPEAL for the above-identified application.

Also attached is our check in the amount of \$320.00 in payment of the brief fee as provided by 37 C.F.R. 1.17(f). Any additional fees necessary to effect the proper and timely filing of this Brief may be charged to Deposit Account No. 26-0090.

RECEIVED

DEC 31 2001

Technology Center 2600

Respectfully submitted,

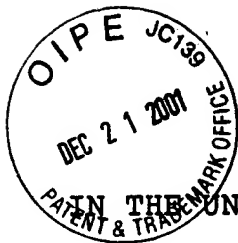
*Jim Zegeer*

Jim Zegeer, Reg. No. 18,957  
Attorney for Appellants

Suite 108  
801 North Pitt Street  
Alexandria, VA 22314  
Telephone: 703-684-8333

Date: December 21, 2001

In the event this paper is deemed not timely filed, the applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 26-0090 along with any other additional fees which may be required with respect to this paper.



Attorney File: 2779-Z

In re Application of  
Lawrence W. Krebs et al  
Serial No. 09/110,661  
Filed: July 7, 1998  
For: ATM NETWORK MANAGEMENT SYSTEM

Group Art Unit 2762  
Examiner B. Phunkulh

BRIEF ON APPEAL

Hon. Commissioner of Patents & Trademarks  
Washington, D. C. 20231

Sir:

This is an appeal from the decision of the Examiner dated June 28, 2001 finally rejecting Claim 1 of the above-identified application.

**I. The Real Party in Interest**

The real party in interest is ITT Manufacturing Enterprises, Inc.

**II. Related Appeals and Interferences**

There are no related appeals or interferences.

**III. Status of the Claims**

Claim 1, the only claim pending in the application, has been finally rejected.

RECEIVED

DEC 26 2001

Technology Center 2100

RECEIVED

DEC 31 2001

Technology Center 2600

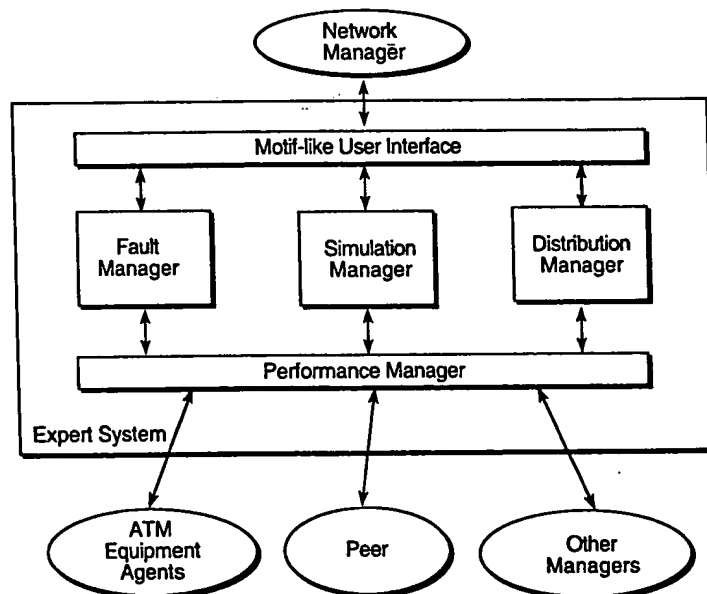
#### IV. Status of the Amendments

A response after final filed August 22, 2001 was entered but did not result in allowance of the application.

#### V. Summary of the Invention

The single drawing in the application is reproduced below for convenience of reference:

FIG. 1



The invention is directed to an asynchronous transfer mode (ATM) management network having fault management, performance management, configuration management, security management and accounting management functions and is directed to the method of operating the system using an inference engine fault manager including correlation of ATM switch failures and traps and automated courses

of action and using an inference engine for the performance management of the ATM management network.

Thus, the invention focuses on two areas of network management: fault management and performance management. The inference engine allows the system to build a set of values for acting upon false alarms generated within the ATM network. The rules provide a level of intelligence and lets users be proactive in the management of their networks rather than to act on a set of individual faults, alarm or message. The system's intelligence correlates these events and recommends a corrective action. Moreover, the invention has the ability to support multiple vendors' ATM switches and incorporates sophisticated intelligence (expert system) into the system's inference engine for heterogeneous ATM environments.

## VI. Issues

The issue presented in this case is whether the Examiner was correct in rejecting Claim 1 under 35 U.S.C. §102(b) as being anticipated by Hearn et al (US 5,640,505).

## VII. Grouping of Claims

The claims stand or fall together.

### VIII. Argument

Appellants respectfully submits that the Examiner's rejection of Claim 1 under 35 U.S.C. §102(b) as being anticipated by Hearn et al (US 5,640,505), hereinafter Hearn is erroneous.

Anticipation under 35 U.S.C. §102(b) requires that every claim limitation be present in a single prior art reference and that there must be no difference between the claimed invention and the reference as viewed by one of ordinary skill in the art. *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 USPQ 2d, 1065 (Fed. Cir. 2000), reh'g denied, in banc suggestion declined, (Dec. 13, 2000) and cert. denied, 121 S. Ct. 1607, 149 L.Ed. 2d 473 (U.S. 2001). Also see *Motorola, Inc. v. Interdigital Tech Corporation*, 43 USPQ 2d 1481 (Fed. Cir. 1997). Claim 1 is a Jepson claim. In a Jepson claim, the words in both the preamble describing the prior art and those elements constituting the improvement are substantive claim limitations. *Mossman v. Borderbund Software*, 51 USPQ 2d 1752 (E.D. Mich. 1999). Thus, if there is a limitation contained in the claim which is not in the reference, there can be no anticipation.

Several limitations and features contained in the claim are not found in Hearn, and the Hearn architecture is different from that claimed.

FIG. 1

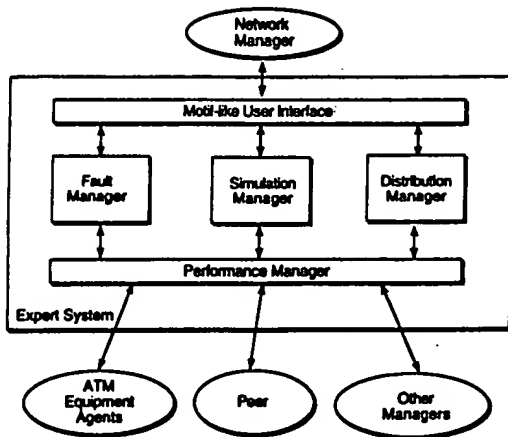


Fig.2.

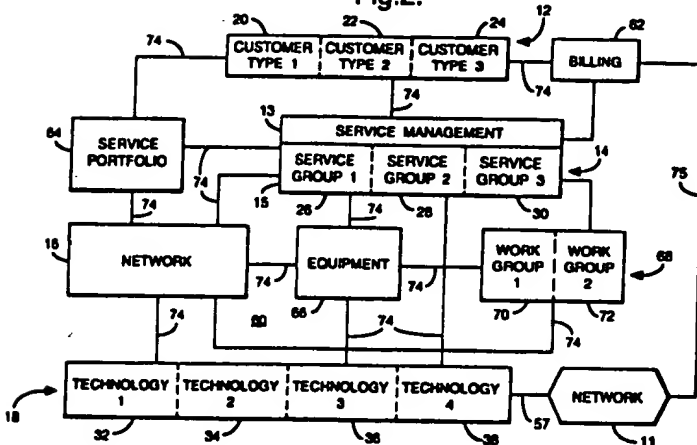
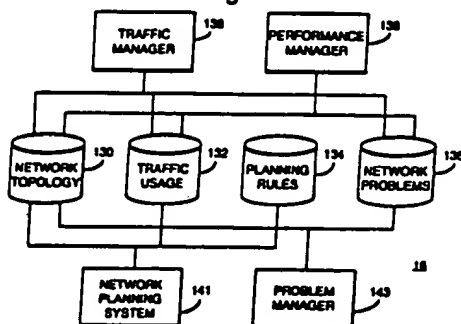


Fig.5.



The single drawing in this application and Figures 2 and 5 of Hearn are reproduced (in reduced and colocated form) to the left hereof for convenience of reference. Note that applicants' Jepson preamble requires that the ATM management network include functional areas, including security management and accounting management. The claim also includes the steps of using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommended courses of corrective action and using an inference engine for the performance management of an ATM management network. The Examiner contends that Hearn discloses a problem manager 143 (which the Examiner equates to applicants' fault manager) for receiving

fault reports from the other domains, using information contained in the database 130 concerning the network topology. It then correlates these faults and identifies the problems which are causing them. The identified problems are recorded in the database 136, and the manager 143 sends instructions (recommendation) to the traffic manager 138, the service domain 14 or the traffic domain 18 to restore lost services and to remove problems (the Examiner referring to Figs 2 and 5 (reproduced above) and col. 1, lines 21-34).

Neither the problem manager nor the traffic manager nor the performance manager of Hearn is characterized as being either an expert system or an inference engine. Hence, it is not clear that the reference utilizes an inference engine fault manager including correlation of ATM switch failures and traps and automating recommended courses of corrective action or that there is an inference engine used for the performance management of the ATM management network. In fact, the terms "inference" and "expert" do not appear in the Hearn disclosure.

CONCLUSION

In view of the above, it is clear that the Examiner erred and should be reversed.

Respectfully submitted,

  
Jim Zegeer, Reg. No. 18,957  
Attorney for Appellants

Attachment: APPENDIX (Claim on appeal)

Suite 108  
801 North Pitt Street  
Alexandria, VA 22314  
Telephone: 703-684-8333

Date: December 21, 2001

In the event this paper is deemed not timely filed, the applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 26-0090 along with any other additional fees which may be required with respect to this paper.



## APPENDIX

1. In an asynchronous transfer mode (ATM) management network, having the following functional areas: fault management, performance management, configuration management, security management and accounting management, the method of operating said ATM management network comprising:

(a) using an inference engine fault manager including correlation of ATM switch failures and traps and automating recommend courses of corrective action, and

(b) using an inference engine for said performance management of said ATM management network.